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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,609	06/12/2006	Andreas Palmer	27413U	2197
34375	7590	04/12/2007	EXAMINER	
NATH & ASSOCIATES PLLC 112 South West Street Alexandria, VA 22314			LEESER, ERICH A	
		ART UNIT	PAPER NUMBER	
		1624		
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	04/12/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/582,609	PALMER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Erich A. Leeser	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 June 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 1-8 is/are allowed.
- 6) Claim(s) 9-12 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9-12-06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

1. Claims 1-12 are pending in this application.

### ***Priority***

2. Acknowledgment is made that this application is a 371 of PCT/EP04/53562, filed on December 17, 2004, which claims foreign priority to applications EPO 030029361.7, filed on December 19, 2003 and EPO 04103550.2, filed on July 23, 2004.

### ***Information Disclosure Statement***

3. The references cited in the IDS, dated September 12, 2006, are made of record.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 9-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The following apply. Any claim not specifically rejected is rejected if it is dependent on a rejected claim and shares the same indefiniteness.

- (a) In claims 9-10, the term "reducing" is not clear. There are no reaction steps for reducing formula 3 to formula 1. How does Applicant reduce formula 3 to make formula 1 in claims 9 and 10? Correction is required.

(b) In claims 11-12, the term “deprotection” is not clear. There are no reaction steps to deprotect formula 1 to arrive at formula 4. How does Applicant deprotect formula 1 to make formula 4 in claims 11-12? Note that the phrase “deprotection of a compound of formula 1 as claimed in claim 1” is also not clear. Claim 1 is a product claim and not a process claim.

(c) In claim 12, the term “cyclization” is not clear. There are no reaction steps to reduce formula 4 to formula 5. How does Applicant cyclicize formula 4 to make formula 5 in claim 12? What are the *steps* involved in making compounds of formula 5?

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

6. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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7. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 9-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of Palmer, copending application 10/582,395. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter embraced in the instant claims is also embraced in copending application 10/582,395. The reduction of formula (3) in claim 9 of the instant application and the reduction of formula (1) in claim 1 of the copending application 10/582,395 involve the same process (i.e., reduction of the carbonyl group to a hydroxy group).

9. Because the steps laid out in the process claims to arrive at the end product are nearly identical between the reference and the instant application, one of ordinary skill would clearly find the subject matter of the instant claims to be obvious in view of the claims of the copending application.

10. This obviousness-type double patenting rejection is provisional because the conflicting claims have not in fact been patented.

*Allowable Subject Matter*

11. Claims 1-8 are patentable over Gold et al., U.S. Patent No. 4,468,400. The reference teaches imidazo[1,2-a]pyridine compounds. The difference between the compounds of Gold et al. and the instant compounds is that where the instant compounds have a protecting group, Gold et al. has a hydroxy group. Therefore, the claims are free of the prior art.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Erich A. Leeser whose telephone number is 571-272-9932. The Examiner can normally be reached Monday through Friday from 8:30 to 6:00 EST.

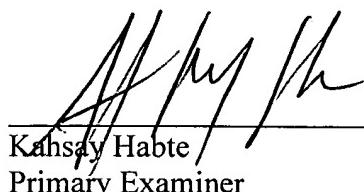
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. James O. Wilson can be reached at 571-272-0661. The fax number for the organization where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system: Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197. If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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Erich A. Leeser  
Assistant Examiner



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Kahsay Habte  
Primary Examiner